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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,669	02/06/2004	Steffen Dubnack	GK-ZEI-3226/500343.20238	7534

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REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

EISEMAN, ADAM JARED

ART UNIT	PAPER NUMBER
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3736

MAIL DATE	DELIVERY MODE
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09/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/773,669	Applicant(s) DUBNACK ET AL.	
	Examiner ADAM J. EISEMAN	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Request for Continued Examination and amendments to claims 1-3 are acknowledged by the examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al (US 5,630,426).

Regarding claim 1; Eggers discloses a method for tissue-selective treatment in surgery comprising:

placing a probe in an area of body tissue of a person being treated (column 5, lines 41-50);

stimulating the area of the body tissue causing the probe to send different electrical and/or electromagnetic stimulus signals which can be preadjusted or modulated (column 5, lines 51-60);

identifying the pathologically changed tissue parts in the area of body tissue by identifying those tissue parts for which the person being treated provides an unexpected stimulus response, wherein the response identified is distinct from the properties of the body tissue being stimulated (column 6, lines 46-52);

treating the area of the body tissue, wherein the treatment comprises the probe, selecting and/or removing any pathologically changed tissue part;

wherein, in the case of healthy tissue, the probe is repositioned and tissue selection is reactivated (column 10, line 64 to column 11, line 11).

4. In regards to claim 2, the stimulus response is carried out by iterative transmission of stimulus signals (column 10, line 64 to column 11, line 11).

5. In regards to claim 3, a direct online tissue selection is carried out by alternating treatment and positioning with tissue selection and immediate evaluation of the stimulus responses (column 10, line 64 to column 11, line 11) and the user is warned during treatment of critical tissue regions (via display 45).

Response to Amendment

6. Applicant's arguments filed 6/24/2008 have been fully considered but are not persuasive.

7. Applicant has amended claims 1-3 to overcome 35 U.S.C. 112 rejections. The examiner accepts the amendments and withdraws the 35 U.S.C. 112 rejections.

8. Applicant argues that Eggers identification and characterization of pathologically changed tissue through measuring of the bioelectric impedance or dielectric constant does not read on "identifying any pathologically changed tissue parts in the area of body

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tissue by identifying those tissue parts that provide no stimulus response or an unexpected stimulus response, *wherein the response identified is distinct from the properties of the body tissue being stimulated....*" In essence the applicant argues that the measurement of the bioelectric impedance or dielectric constant are not stimulus responses according the original application citing paragraph [0019] of the publication.

9. The argument is not persuasive as the original specification claims:

The following changes or influences can be used, for example, to evaluate the stimulus signals sent to the tissue: changes in the EKG or EGG; affect on sight, hearing or speech; muscular tremors; movements of extremities or body parts; affect on equilibrium; changes in cardiovascular system, e.g. changes in heart rate or fibrillation; and affect on memory, logical thought or motor skills.

The examiner has underlined for emphasis: the changes or influence can be used, for example. Thus the specification does not limit what one would use to identify pathologically changed tissue; it merely suggests possible examples of influences and changes which can be used for distinction. Furthermore, the examiner contends that a bioelectrical impedance measurement of tissue that characterizes the tissue is malignant, by definition identifies a response that is distinct from the properties of the body tissue being stimulated; as normal tissue would give a normal bioelectrical impedance measurement.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM J. EISEMAN whose telephone number is (571)270-3818. The examiner can normally be reached on Mon-Thurs, 8:00 PM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. J. E./
Examiner, Art Unit 3736
9/11/2008

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736